

REMARKS

After entry of the foregoing amendment, claims 6-9 and 12-27 are pending in the application.

Claims 1-5, 10 and 11 are cancelled; applicant reserves the right to pursue claims of the same, or commensurate, scope in this or another application.

Claims 12-27 are newly added.

Applicant respectfully traverses the rejection of claim 6, and claims dependent thereon.

With hindsight, it is straightforward to see how the claimed arrangement might be assembled from the prior art. Indeed, rare is the invention that does not essentially consist of elements previously known. At issue, however, is whether the presently claimed arrangements would have been obvious to an artisan in November, 2000 (the provisional priority date) – taking the prior art at face value.

Applicant respectfully submits that nothing in the art would have led an artisan to such combination. Contemporaneous motivation is missing. Nothing in Chen, nor the Steinhorn ATVEF article cited by applicant, would have motivated an artisan to take the respective components of the present invention, and combine them in the particular manner claimed.

The September 13, 2006, Action predicates the proposed combination on the logic that it would have been obvious “... *to make Chen’s system compatible with a widely embraced industry standard.*” But that begs the question, ‘why?’ Why would an artisan have sought to make Chen compatible with the ATVEF standard? Was there some deficiency in the ATVEF standard? Was there some deficiency in Chen? Why would the artisan have been motivated to do as the Action proposed? Neither reference provides such motivation.

Citing an advantage achieved by the making of the invention, and then offering this advantage as a rationale that would have led to the invention’s creation, is to fall victim to hindsight. It is circular. The correct inquiry, instead, is to take the prior art for what it teaches, and consider whether the claimed combination is among those

combinations, if any, that such teachings would have motivated - and why. In the present case, there is no such analysis.

Moreover, the offered rationale proves too much. If making a technology applicable to a widely embraced industry standard establishes *per se* obviousness, then widely embraced industry standards are essentially immune from patentable improvements. The Board will recognize that such logic is flawed, and that the rejection of claim 6 on such basis cannot stand.

As regards dependent claim 9, the Action has not addressed the point that the claimed combination includes *both* a watermark decoder and a multicast IP decoder. Since Steinhorn already includes a multicast IP decoder, no motivation is offered for including a further encoder in such system. Again, applicant respectfully submits that such rejection should be withdrawn.

Turning to the newly submitted claims, audio and still image watermark decoding (*c.f.*, claims 13, 14, 18 and 19) are taught, e.g., by commonly-owned patent 6,122,403, cited at page 1 line 25 of the present application. The '403 patent was expressly incorporated-by-reference into the present specification by language at page 4, lines 6-7. Applicant noted, at page 4, lines 12-13, that "*Any watermarking technology can be employed.*"

New claims 21-27 rely on commonly-owned patent 6,947,571 for some of their support. (The '571 patent - originally identified as application 09/571,422 - was incorporated by reference at page 4, line 8 of the present specification.)

Applicant taught applicability of elements and features from the present specification in the arrangements detailed in the incorporated-by-reference documents by language at page 4, lines 22-25.

The Examiner is invited to telephone the undersigned if it might aid in disposition of this application.

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Respectfully submitted,

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